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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,228	12/31/2001	Michael T. Tessmer	5102US (01-01-068)	7278
4743	7590	05/05/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			COBURN, CORBETT B	
		ART UNIT	PAPER NUMBER	
		3714		

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**DETAILED ACTION**

1. On 9 April 2004, Applicant filed an amendment to the claims canceling all previous claims and substituting new claims. On 12 July 2004, Examiner placed a restriction requirement on these new claims citing election by original presentation. Applicant was required to elect at least one claim drawn to the original invention. Applicant has failed to make such an election.
2. Instead of making the required election, Applicant has argued that the newly claimed invention is the same as the previously claimed invention. Applicant has argued that there are similarities between original claim 12 and new claim 85. A quick review of the claims will show that the Applicant's arguments are in error.

Original Claim 12 recites:

The method in claim 11 wherein the first advantage comprises at least one of:

an initial shortening of a paddle of an opponent;  
an initial lengthening of a paddle of the player; and  
a slower shrinkage of a paddle of the player than a paddle of an opponent.

New Claim 85 recites:

A gaming apparatus comprising:

one or more display units;  
a wager input device; and  
a processor operatively coupled to at least one of the one or more display units, the wager input device, and a memory,  
the processor receiving a wager via the wager input device from a player,

the processor causing one of the one or more display units to display an image representative of a primary game,

the processor determining if a bonus event trigger has occurred,

the processor causing one of the one or more display units to display an image representative of a ping-pong game playable between a paddle associated with a player and a paddle associated with an opponent, if the bonus event trigger occurs,

the processor offering the player at least one advantage option, the at least one advantage option affecting at least one of the paddle associated with the player and the paddle associated with the opponent,

the processor determining a payout associated with an outcome of the ping-pong game.

3. The first and most obvious difference between the two claims is that Claim 12 is directed to a method while Claim 85 is directed to an apparatus. Furthermore, following Claims 12 chain of dependency to the independent claim there is no mention of a wagering game in the originally filed claims. In other words, the method of the originally filed Claim 12 can be carried out on a materially different apparatus than that claimed in Claim 85. Claim 12 could be carried out on either an arcade game, or a game console – neither of which even allow wagering.

4. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process can be practiced on another materially different apparatus such as a videogame console.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. *Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).*

*Response to Amendment*

7. The reply filed on 16 August 2004 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Failure to elect. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Jessica Harrison can be reached on (571) 272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Corbett B. Coburn  
Examiner  
Art Unit 3714